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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,844	06/30/2000	Kia Silverbrook	NPB004US	9775

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,844

Applicant(s)

SILVERBROOK ET AL.

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The following application has been reviewed. Any objections and rejections are cited below:

Claim Objections

1. Claim 21 is objected to because of the following informalities: A comma is required between the words first and second. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5, 12, 14, 16, 23-24, 26-27, and 29-35 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Holmes et al. (hereinafter Holmes) U.S. Patent 6,119,108.

Regarding claims 1 and 32, Holmes discloses a method and system to improve distribution of electronic objects and enforcing copyright protection. A user interfaces with an electronic object database containing printed media, requests a certain document from the database and then allowing the document to be displayed or printed by the user (column 4, line 59 thru column 5, line 24).

An identifier is applied to the printed media such that when the user selects the desired document a second printed media is sent to the user from the payment information database (column 5, lines 40-66).

The system also comprises a memory means for storing account data and records of the objects the user purchases (column 8, lines 37-39).

Claims 2 and 33, both of the databases are accessed through a server connecting the databases (column 7, lines 10-18). A calculation is based on account data for determining the amount of payment that is made to the user (column 4, lines 34-58).

Claims 3 and 4, the server means for constituted by respective hardware and software as well as common hardware and/or software (column 4, lines 1-33).

Claim 5, the first and second databases are separate from one another (Figure 1).

Claim 12, the module is provided to the user from another party and the calculation means is responsive to the account data for determining a financial debit to be applied by the party against the user (column 4, line 34 thru column 5, line 24).

Claim 14, the system is capable of a plurality of computers corresponding to a plurality of users and the calculation means being able to store account data and records of the objects the user purchases (column 8, lines 37-39).

Claim 16, the account database stores the information associated with the purchase for auditing purposes and the system keeps track of any subsequent attempts to access the document (column 5, line 12 thru column 6, line 23).

Claims 23 and 24, the calculation means is responsive to the account data for determining the payment to be made by the user (column 4, lines 34-58).

Regarding claims 26 and 34, Holmes discloses a method and system to improve distribution of electronic objects and enforcing copyright protection. A user interfaces with an electronic object database containing printed media, requests a certain document from the database and then allowing the document to be displayed or printed by the user (column 4, line 59 thru column 5, line 24).

An identifier is applied to the printed media such that when the user selects the desired document a second printed media is sent to the user from the payment information database (column 5, lines 40-66).

The system also comprises a memory means for storing account data and records of the objects the user purchases (column 8, lines 37-39).

Payment determination is responsive to the account data for calculating a licensing fee to be levied against the user for the desired access (column 4, lines 34-58).

Claims 27 and 35, the payment balance is determined from a balance of predetermined periodic payments and credit derived from the account data (column 4, lines 33-58).

Claims 29, the payment determines a positive value for the access fee (column 5, lines 1-24).

Claim 30, the payment determination means calculates the access fee periodically (column 4, lines 34-39).

Claim 31, the print media is cancelled from being transmitted if the financial transaction is not completed (column 8, lines 52-56).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 6-9, 10-11, 13, 15, 17-22, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al. (hereinafter Holmes) U.S. Patent 6,119,108.

Claim 6, Holmes teaches that the user receiving information from the databases are of the same legal entity. Holmes fails to teach that the users could be of different legal entities.

Official Notice is taken that the use of two different legal entities for transmitting information from databases is old and well known in the art. Therefore it would have been obvious at the time of the Applicant's invention to modify the teachings of Holmes to include sending first information from one database to a first user and second information from a second database to a

second user, because it is commonly practiced when purchasing items for other people, sending the necessary item to the recipient and the purchase agreement to the payor.

Claims 7 and 15, Holmes teaches that the two databases in the system are separate from one another. Holmes fails to teach that the databases could be different portions of the single database. Official Notice is taken that the use of one database divided into two portions is old and well known in the art. Therefore it would have been obvious at the time of the Applicant's invention to modify the teachings of Holmes to include databases made up of different portions of the single database, because it allows for greater flexibility in designing the system.

Claim 8, Holmes teaches that the party receiving first information and second information are of the same legal entity (column 4, line 60 thru column 5, line 44).

Claim 9, Holmes teaches that the second information derived by a party separate from the original user and the calculation means is responsive to account data for determining the debt applied to the original user (column 4, lines 34-58).

Claim 10, Holmes teaches a memory means for storing account data and records of the objects the user purchases (column 8, lines 37-39) and that the calculation means is responsive to account data for determining the debt applied to the original user (column 4, lines 34-58).

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Holmes fails to teach that the users could be of different legal entities. Official Notice is taken that the use of two different legal entities for transmitting information from databases is old and well known in the art. Therefore it would have been obvious at the time of the Applicant's invention to modify the teachings of Holmes to include sending first information from one database to a first user and second information from a second database to a second user, because it is commonly practiced when purchasing items for other people, sending the necessary item to the recipient and the purchase agreement to the payor.

Claims 11, 13 and 28, Holmes teaches the use of account data to determine the debit from accessing the print media. Holmes fails to teach that the debit is proportional to an account data number. Official Notice is taken that proportional payments are old and well known in the art. Therefore it would have been obvious at the time of the Applicant's invention to modify the teachings of Holmes to include promotional payments because they are common way of pricing items based on account data.

Claims 17-20, Holmes teaches a method of payment that is standard of paying a fee for a license to the print media. Holmes fails to teach paying a predetermined amount based on the number of times the media is accessed. Holmes also fails to teach if a credit balance exceeds certain limits, the user may acquire a benefit. Official Notice is taken that many different payment schemes may be applied to this system. Therefore it would have been obvious at the time of the Applicant's invention to modify the teachings of Holmes to include a payment

schemed that is based on the number of visits as well as providing benefits for exceeding credit limits because they are commonly practiced in the business world in other transactions.

Claims 21, Holmes teaches one or more of the parties involved in the system are providers of goods and/or services (column 2, lines 26-51).

Claim 22, Holmes teaches that a party other than the original user is a provider of goods and/or services (column 2, lines 26-51).

Claim 25, Holmes teaches that the calculation means is responsive to the account data from a user to a certain party. Holmes fails to teach that separate legal entities for the parties providing first and second information. Official Notice is taken that payments between the parties involved are old and well known in the art. Therefore it would have been obvious at the time of the Applicant's invention to modify the teachings of Holmes to include separate legal entities that pay one another because everyone contributing to the process of the system will require a fee for their service.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Hartrick et al., US Patent 5,532,920 Jul. 2, 1996. Data processing system and method to enforce payment of royalties when copying softcopy books.

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b) Schull, US Patent 5,509,070 Apr. 16, 1996. Method for encouraging purchase of executable and non-executable software.


c) Enomoto et al., US Patent 5,974,401 Oct. 26, 1999. Digital print order and delivery method and system.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

Respectfully Submitted
Stefano Karmis
June 25, 2003



HANI M. KAZIMI
PRIMARY EXAMINER